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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,954	03/30/2001	David W. Cannell	05725.0637-00	7371

22852 7590 12/31/2002

FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20006

EXAMINER

WILLIS, MICHAEL A

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 12/31/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,954

Applicant(s)

CANNELL ET AL.

Examiner

Michael A. Willis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 and 39-77 is/are pending in the application.
- 4a) Of the above claim(s) 1-36, 40, 42, 44-46, 50-57, 59, 64 and 65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 37, 39, 41, 43, 47-49, 58, 60-63, 66-77 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 11.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Applicant's amendment of 17 October 2002 is entered. Claim 38 is cancelled.

Claims 37 and 71 are amended. Claims 73-76 are added. Claims 1-37 and 39-77 are pending. Any previous rejections that are not restated in this Office Action are hereby withdrawn. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Election/Restrictions

As indicated previously, Claims 1-36 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected invention.

As indicated previously, Claims 40, 42, 44-46, 50-57, 59, and 64-65 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to non-elected species.

Claims 37, 39, 41, 43, 47-49, 58, 60-63, 66-72 and new claims 73-77 are examined as they read on a) glucosamine as the species of C5-C7 saccharide substituted with at least one amino group and b) xylose as the at least one additional sugar.

Specification

The objection to the specification is withdrawn in view of applicant's deletion of the brief description of the drawing, page 8, lines 5-11 of the specification. The request to add a drawing in applicant's response of 17 October

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2002 could not be followed, as a drawing could not be located. In a telephone interview, applicant indicated that a drawing has not been submitted.

Response to Arguments

Claims 37, 39, 41, 43, 47-49, 58, and 69-71 and new claims 73-77 are rejected under 35 USC 102(b) as being clearly anticipated by Williams et al (US Pat. 5,679,344) for reasons as stated previously.

Applicant argues that Williams fails to teach heat-activated compositions for protecting or repairing at least one keratinous fiber. Applicant's arguments are not convincing in that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. In the instant application, the claims are drawn to compositions rather than methods of protecting or repairing at least one keratinous fiber. Therefore, the phrase "wherein said composition is heat-activated" is not given patentable weight. With respect to new claims 73-77, the patentability of a product does not depend on its method of production. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See also MPEP 2113. The process of heating the composition to above 80°C or 100°C does not change the fact that the only limitation on the composition is that it comprises glucosamine.

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Claims 37, 39, 41, 43, 47-49, 58, 60-61, 63, 68-71 and 73-77 are rejected under 35 USC 102(b) as being clearly anticipated by Noel (US Pat. 5,141,964) for reasons as stated previously.

Applicant argues that Noel does not teach a heat-activated composition for protecting or repairing at least one keratinous fiber. Applicant's arguments are not convincing in that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. In the instant application, the claims are drawn to compositions rather than methods of protecting or repairing at least one keratinous fiber. Therefore, the phrase "wherein said composition is heat-activated" is not given patentable weight. With respect to new claims 73-77, the patentability of a product does not depend on its method of production. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See also MPEP 2113. The process of heating the composition to above 80°C or 100°C does not change the fact that the only limitation on the composition is that it comprises glucosamine.

Claims 37, 39, 41, 43, 47-49, 58, 60-63, and 66-77 are rejected under 35 USC 102(e) as being anticipated by Heisey et al (WO 01/93831) for reasons as stated previously.

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Applicant argues that Heisey does not teach a heat-activated composition for protecting or repairing at least one keratinous fiber. Applicant's arguments are not convincing in that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. In the instant application, the claims are drawn to compositions rather than methods of protecting or repairing at least one keratinous fiber. Therefore, the phrase "wherein said composition is heat-activated" is not given patentable weight. With respect to new claims 73-77, the patentability of a product does not depend on its method of production. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See also MPEP 2113. The process of heating the composition to above 80°C or 100°C does not change the fact that the only limitation on the composition is that it comprises glucosamine.

Claims 37, 39, 41, 43, 47-49, 58, 60-63, and 66-77 are rejected under 35 USC 103(a) as being unpatentable over Heisey et al (WO 01/93831) for reasons as stated previously.

Applicant argues that Heisey does not teach or disclose a heat-activated composition. Applicant's arguments are not convincing in that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish

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the claimed invention from the prior art. In the instant application, the claims are drawn to compositions rather than methods of protecting or repairing at least one keratinous fiber. Therefore, the phrase "wherein said composition is heat-activated" is not given patentable weight. With respect to new claims 73-77, the patentability of a product does not depend on its method of production. If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See also MPEP 2113. The process of heating the composition to above 80°C or 100°C does not change the fact that the only limitation on the composition is that it comprises glucosamine.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will


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the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

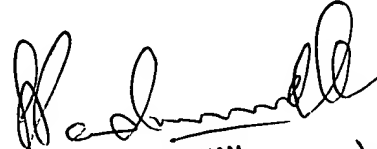
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael A. Willis whose telephone number is (703) 305-1679. The examiner can normally be reached on alt. Mondays and Tuesday to Friday (9am-6:30pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703) 305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.


Michael A. Willis
Examiner
Art Unit 1617

maw
December 27, 2002


SREENI PADMANABHAN
PRIMARY EXAMINER
12/30/02